**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

      Jerding, *et al.*

Serial No.: 09/692,995

Filed: October 20, 2000

For: **Media-On-Demand Bookmark System**

Confirmation No.: 8091

Group Art Unit: 2623

Examiner: Beliveau, Scott E.

Docket No. A-6687 (191910-1570)

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief - Patents:
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

      This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of

Appeal filed on January 8, 2007, responding to the Office Action mailed September 8, 2006

(Part of Paper No./Mail Date 20060902), rejecting claims 80, 82, 83, 85, 86, and 90-101 in the

present application and making the rejection FINAL.

I. **REAL PARTY IN INTEREST**

      The real party in interest of the instant application is Scientific-Atlanta, Inc., having its

principal place of business at 5030 Sugarloaf Parkway, Lawrenceville, GA 30044. Scientific-

Atlanta, Inc., the assignee of record, is wholly owned by Cisco Systems, Inc.

II. **RELATED APPEALS AND INTERFERENCES**

      There are no related appeals or interferences.

III. <u>STATUS OF THE CLAIMS</u>

Claims 80, 82, 83, 85, 86, and 90-101 are pending in the present application. Through prosecution of this matter, claims 1-79, 81, 84, 87-89, and 102-122 have been canceled without prejudice, waiver, or disclaimer. Claims 80, 82, 83, 85, 86, and 90-101 were rejected by the FINAL Office Action and are the subject of this appeal. An Advisory Action, dated November 27, 2006, indicated that the response after final submitted by Applicants on November 8, 2006 did not place the application in condition for allowance. A Notice of Panel Decision from the Pre-Appeal Brief Review, dated February 28, 2007, indicated that the application remains under appeal because there is at least one actual issue for appeal.

IV. <u>STATUS OF AMENDMENTS</u>

An amendment to claim 96 was made in a response after final mailed on November 8, 2006, and was entered, according to the Advisory Action dated November 27, 2006. Additionally, all amendments submitted prior to the FINAL action have been entered. A copy of the currently pending claims is attached hereto as Appendix, section IX.

V. <u>SUMMARY OF THE CLAIMED SUBJECT MATTER</u>

Embodiments of the claimed subject matter are illustrated in FIGs. 1-14 and are discussed in the specification at least at pages 4-19.

Embodiments of the claimed subject matter, such as those defined by claim 80, define a method implemented by a television set-top terminal (STT) (see, *e.g.*, FIG. 3, reference numeral 16, and page 7, lines 20 – page 12, line 26) coupled via a bi-directional communication network (see, *e.g.*, FIGS. 1 and 3, reference numeral 18, and page 5, lines 6-8 and page 7, lines 25-28) to a server (see, *e.g.*, FIG. 2, reference numeral 22, and page

7, line 4 – 14, and page 11, lines 18-21) located remotely from the STT in a cable television

headend (see, *e.g.*, FIG. 2, reference numeral 11, and page 5, line 23 – page 7, line 19),

said method comprising steps of: receiving via a tuner (see, *e.g.*, FIG. 3, reference numeral

45, and page 6, lines 5-9 and page 8, lines 1-7) in the STT a video presentation (see, *e.g.*,

page 11, lines 18-21) provided by the server located in the cable television headend,

wherein the video presentation is a video-on-demand presentation (see, *e.g.*, page 18, lines

23-25); outputting by the STT at least a portion of the video presentation as a video-on-

demand television signal (see, *e.g.*, page 7, lines 28 – page 8, line 3); receiving a first user

input associated with bookmarking a visual scene contained in the video presentation (see,

e.g., FIGs. 3, 4, 7, and 14, reference numerals 80, 46, 87, and 123, and page 10, lines 3-8,

page 13, lines 1-5, page 14, line 25 – page 15, line 6, and page 14, line 16 – page 15, line 6

(the latter cite partially through amendment of August 3, 2005)), including receiving a

character sequence to be assigned to the visual scene while the video presentation is being

presented to the user (see, *e.g.*, FIG. 8, and page 15, lines 19 – 23 and page 17, lines 1-9);

storing information related to the visual scene in a memory (see, *e.g.*, FIG. 3, reference

numeral 52, and page 8, line 15 – page 9, line 4, and page 16, lines 4-19) of the STT

responsive to receiving the first user input, including storing only in the memory of the STT

information related to the visual scene in response to receiving the first user input (see, *e.g.*,

page 16, lines 4-9), including storing only in the memory of the STT data corresponding to

the character sequence in response to receiving the user input configured to assign the

character sequence to the visual scene (see, *e.g.*, page 16, lines 15 – 29); outputting by the

STT at least another portion of the video presentation as a video-on-demand television

signal (see, *e.g.*, page 15, lines 1- 6); receiving a second user input configured to request

from the headend the visual scene in the video presentation after the STT has output the at

least another portion of the video presentation (see, *e.g.*, FIGs. 2, 3, 10 - 12, reference

numerals 19, 21, 22, 63, and 152, and page 5, line 23 – page 6, line 4, page 7, lines 4 – 14,

page 11, lines 18-21, and page 17, line 10 – page 18, line 22); responsive to receiving the second user input, requesting by the STT that the headend send the video presentation beginning from the requested visual scene (see, *e.g.*, FIGs. 2, 3, 10 - 12, reference numerals 19, 21, 22, 63, and 152, and page 5, line 23 – page 6, line 4, page 7, lines 4 – 14, page 11, lines 18-21, and page 17, line 10 – page 18, line 22); receiving by the STT from the headend the video presentation beginning from the requested visual scene (see, *e.g.*, FIGs. 2, 3, 10 - 12, reference numerals 19, 21, 22, 63, and 152, and page 5, line 23 – page 6, line 4, page 7, lines 4 – 14, page 11, lines 18-21, and page 17, line 10 – page 18, line 22); and outputting by the STT a video-on-demand television signal comprising a portion of the video presentation starting from a location corresponding to the visual scene responsive to the second user input, wherein the location corresponding to the visual scene is identified by the STT using the information related to the visual scene, including using information related to the visual scene stored only in the STT (see, *e.g.*, FIGs. 2, 3, 10 - 12, reference numerals 19, 21, 22, 63, and 152, and page 5, line 23 – page 6, line 4, page 7, lines 4 – 14, page 11, lines 18-21, page 17, line 10 – page 18, line 22, and page 16, lines 4-29).

Embodiments of the claimed subject matter, such as those defined by claim 93, which further define the method of claim 80, further comprise after expiration of a rental access period corresponding to the video presentation, prompting the user to provide input indicating whether the information is to be deleted from the memory of the STT (see, *e.g.*, page 19, lines 20 – 25).

Embodiments of the claimed subject matter, such as those defined by claim 94, which further define the method of claim 80, further comprise storing an image corresponding to the visual scene in a memory of the STT responsive to receiving the first user input (see, *e.g.*, page 16, lines 4-29).

Embodiments of the claimed subject matter, such as those defined by claim 95, further define the method of claim 80, wherein the second user input requesting the visual

scene corresponds to a thumbnail image corresponding to the visual scene, the thumbnail image being simultaneously provided with a plurality of thumbnail images corresponding to a plurality of visual scenes in the video presentation (see, *e.g.*, FIG. 10, reference numeral 152, and page 17, lines 10 - 26).

Embodiments of the claimed subject matter, such as those defined by claim 96, define a television set-top terminal (STT) (see, *e.g.*, FIG. 3, reference numeral 16, and page 7, lines 20 – page 12, line 26) coupled via a bi-directional communication network (see, *e.g.*, FIGS. 1 and 3, reference numeral 18, and page 5, lines 6-8 and page 7, lines 25-28) to a server (see, *e.g.*, FIG. 2, reference numeral 22, and page 7, line 4 – 14, and page 11, lines 18-21) located remotely from the STT in a cable television headend (see, *e.g.*, FIG. 2, reference numeral 11, and page 5, line 23 – page 7, line 19), said STT comprising: a tuner (see, *e.g.*, FIG. 3, reference numeral 45, and page 6, lines 5-9 and page 8, lines 1-7,) configured to receive a motion video presentation (see, *e.g.*, page 11, lines 18-21) provided by the server located in the cable television headend, wherein the video presentation is a video-on-demand presentation (see, *e.g.*, page 18, lines 23-25); a memory (see, *e.g.*, FIG. 3, reference numeral 52, and page 8, line 15 – page 9, line 4); and a processor (see, *e.g.*, FIG. 3, reference numeral 44, and page 8, line 15 – page 9, line 4) that is programmed to enable the STT to, output at least a portion of the motion video presentation as a video-on-demand television signal (see, *e.g.*, page 7, lines 28 – page 8, line 3), store information related to a visual scene contained in the motion video presentation only in the memory of the STT (see, *e.g.*, FIG. 3, reference numeral 52, and page 8, line 15 – page 9, line 4, and page 16, lines 4-19) responsive to the STT receiving a first user input associated with the visual scene, without stopping output of the motion video presentation (see, *e.g.*, FIGs. 3, 4, 7, and 14, reference numerals 80, 46, 87, and 123, and page 10, lines 3-8, page 13, lines 1-5, page 14, line 25 – page 15, line 6, and page 14, line 16 – page 15, line 6 (the latter cite partially through amendment of August 3, 2005)), wherein the first user input includes a character sequence to be assigned to the visual scene (see, *e.g.*, FIG. 8, and page

15, lines 19 – 23, and page 17, lines 1-9), and wherein the information related to the visual

scene includes data corresponding to the character sequence, output at least another portion of

the motion video presentation as a video-on-demand television signal (see, *e.g.*, page 15, lines

1- 6), receive a second user input configured to request from the headend the visual scene in

the video presentation after the STT has output the at least another portion of the motion video

presentation (see, *e.g.*, FIGs. 2, 3, 10 - 12, reference numerals 19, 21, 22, 63, and 152, and

page 5, line 23 – page 6, line 4, page 7, lines 4 – 14, page 11, lines 18-21, and page 17, line 10

– page 18, line 22), responsive to receiving the second user input at the STT, request that the

headend send the motion video presentation beginning from the requested visual scene (see,

e.g., FIGs. 2, 3, 10 - 12, reference numerals 19, 21, 22, 63, and 152, and page 5, line 23 – page

6, line 4, page 7, lines 4 – 14, page 11, lines 18-21, and page 17, line 10 – page 18, line 22),

receive from the headend the motion video presentation beginning from the requested visual

scene (see, *e.g.*, FIGs. 2, 3, 10 - 12, reference numerals 19, 21, 22, 63, and 152, and page 5,

line 23 – page 6, line 4, page 7, lines 4 – 14, page 11, lines 18-21, and page 17, line 10 – page

18, line 22), and output responsive to the STT receiving a second user input a video-on-demand

television signal comprising a portion of the motion video presentation starting from a location

corresponding to the visual scene, including using information related to the visual scene stored

only the memory of the STT, wherein the video-on-demand television signal comprising the

portion of the motion video presentation starting from a location corresponding to the visual

scene is output after the at least another portion of the motion video presentation is output as a

video-on-demand television signal (see, *e.g.*, FIGs. 2, 3, 10 - 12, reference numerals 19, 21, 22,

63, and 152, and page 5, line 23 – page 6, line 4, page 7, lines 4 – 14, page 11, lines 18-21,

page 17, line 10 – page 18, line 22, and page 16, lines 4-29).

Embodiments of the claimed subject matter, such as those defined by claim 101,

further define the STT of claim 96, wherein the processor is configured to enable the STT to

store in the memory an image corresponding to the visual scene responsive to receiving the

first user input (see, *e.g.*, page 16, lines 4 – 29).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The FINAL Office Action rejected claims 80, 82, 83, 85, 86, 90-92, 96-100 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *White* ("*White,*" U.S. Patent No. 6,628,302 B2) in view of *Lewis et al.* ("*Lewis,*" WO 00/04726 A2).

The FINAL Office Action rejected claims 93-95 and 101 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *White* in view of *Lewis*, and in further view of *Wang* ("*Wang,*" U.S. Patent No. 6,501,902 B1).

VII. ARGUMENT

The FINAL Office Action has rejected claims 80, 82, 83, 85, 86, and 90-101 as allegedly unpatentable over the various combinations of references described in Section VI above. For at least the reasons set forth herein, Applicants respectfully disagree with the rejections and request that the rejections be overturned.

I. Discussion of Rejections of Claims 80, 82, 83, 85, 86, 90-92, 96-100 Under 35 U.S.C. § 103(a) pertaining to *White* in view of *Lewis*

A.   Independent Claim 80

Claim 80 recites (emphasis added):

> 80.   A method implemented by a television set-top terminal (STT) coupled via a bi-directional communication network to a server located remotely from the STT in a cable television headend, said method comprising steps of:
> receiving via a tuner in the STT a video presentation provided by the server located in the cable television headend, wherein the video presentation is a video-on-demand presentation;
> outputting by the STT at least a portion of the video presentation as a video-on-demand television signal;
> receiving a first user input associated with bookmarking a visual scene contained in the video presentation, including receiving

a character sequence to be assigned to the visual scene while the video presentation is being presented to the user;

storing information related to the visual scene in a memory of the STT responsive to receiving the first user input, including storing only in the memory of the STT information related to the visual scene in response to receiving the first user input, including storing only in the memory of the STT data corresponding to the character sequence in response to receiving the user input configured to assign the character sequence to the visual scene;

outputting by the STT at least another portion of the video presentation as a video-on-demand television signal;

receiving a second user input configured to request from the headend the visual scene in the video presentation after the STT has output at least another portion of the video presentation;

responsive to receiving the second user input, requesting by the STT that the headend send the video presentation beginning from the requested visual scene;

receiving by the STT from the headend the video presentation beginning from the requested visual scene;

outputting by the STT a video-on-demand television signal comprising a portion of the video presentation starting from a location corresponding to the visual scene responsive to the second user input, wherein the location corresponding to the visual scene is identified by the STT using the information related to the visual scene, including using information related to the visual scene stored only in the STT; and

storing an image corresponding to the visual scene in a memory of the STT responsive to receiving the first user input.

Applicants respectfully submit that *White* in view of *Lewis* does not disclose, teach, or suggest at least the above emphasized claim features, and thus, Applicants respectfully submit that independent claim 80 is allowable over *White* in view of *Lewis.*

Specifically, *White* (Col. 5, ln. 10-58, emphasis added) describes the operation of a headend and a client when a user uses stop or pause functions:

> A data record is stored–either at the client, at the head-end, or at a proxy server––indicating the point of video interruption (e.g. by SMPTE code, disk address, time offset, etc.) so that playback can be resumed from that point (or shortly before that point, to provide context).

> When either the STOP or PAUSE button is activated on the panel 74, the panel 74 persists on the screen, but the highlighting is switched back to PLAY. (If the PAUSE button is used to resume playback following a pause instruction, and the user activates the PAUSE button to interrupt the video, the highlighting can remain at the PAUSE button.) This arrangement permits the viewer to resume playback simply by pressing "Go" on the remote, since the button that resumes

playback is already highlighted. (The panel similarly persists on-screen if the REWIND or FAST FORWARD buttons is activated, with PLAY next highlighted.)

The screen can be put to various uses while the video is interrupted. Examples include presentation of quizzes and other entertainment to viewers who may still be in the viewing room. An indication of waiting email, or commercial or promotional messages, can similarly be presented.

If the stop in playback is brief, the system 10 maintains the assignment of the transmission channel to that video on demand client 14, despite the interruption in video delivery. However, if the interruption period exceeds a threshold value (e.g. ten minutes), the system returns the assigned transmission channel back to the system's pool of available transmission channels. The channel may then be assigned to another use. If the user thereafter resumes playback by pressing "Go" on the remote (PLAY was already highlighted), the system responds by dynamically assigning a new transmission channel, retuning the client's RF tuner and the head-end's modulator accordingly, and resuming playback from (or just before) the point of interruption.

A similar sequence occurs if the user changes to another viewer channel during playback of an on-demand video (e.g. changing to MSNBC to check a sports score). The system interrupts delivery of the on-demand video (e.g. in response to an instruction or notification sent by the client), and a record indicating the point of MPEG interruption is stored. If the user returns to the VIDEO viewer channel within a predetermined period (e.g. 24 hours), the system resumes transmission of the video from the point of interruption. (No user action, e.g. pressing PLAY, is required--no video control panel is presented in this scenario.) Again, the resumed transmission may occur over a different transmission channel, but this detail is transparent to the user.

Applicants respectfully submit that it is clear from the above emphasized text that *White* does not appear to describe "receiving a second user input configured to request from the headend the visual scene in the video presentation ___*after* the STT has output at least another portion of the video presentation_" of claim 80. Even assuming, *arguendo*, that *White* discusses VOD, it is in the context of the stop or pause functions (or changing the channel during playback). Once the stop or pause functions of *White* are activated, the system in *White* does not appear to output any portion of content from the given video presentation as claimed in claim 80.

Further, in the Continuation Sheet of the Advisory Action dated November 27, 2006, the Examiner erroneously omits one or more essential elements needed for a prima facie rejection, namely "receiving a second user input configured to request from the headend the visual

scene in the video presentation *after the STT has output at least another portion of the video presentation*" and "responsive to receiving the second user input, *requesting by the STT that the headend send the video presentation beginning from the requested visual scene.*" In other words, claim 80 requires the STT to deliver the video presentation both during and after the bookmarking, and that the visual scene be delivered by the headend based on locally-stored (local to the STT) information pertaining to the visual scene.

In the Advisory Action dated November 27, 2006 (Continuation sheet), the Examiner alleges that *White* "clearly include[s] the particular output of multiple portions of a video both prior to and subsequent to the various playback commands." Applicants respectfully submit that *White*, which appears *arguendo* to describe stop and pause functions in the context of interaction between a headend and a client (and not bookmarking functions), does not show the multiple portions of video as claimed since, as explained on pages 11-12 in Applicants' response dated November 8, 2006, once the stop or pause functions of *White* are activated, the system in *White* does not appear to output any portion of content until resumption from the scene from which the interruption was commenced. That is, the system in *White* does not show that a previously bookmarked visual scene can be requested by the STT and delivered by the headend after the headend has delivered content from the same presentation beyond that bookmarked scene since, according to *White*, no content from a given presentation is delivered by the headend after a pause or stop. Thus, not only is bookmarking not the same as stop and pause functions, but the Examiner has omitted these explicit claim elements needed for a prima facie rejection, and thus the rejection is improper.

Further, *White* does not appear to disclose the feature of "responsive to receiving the second user input, *requesting by the STT that the headend send the video presentation beginning from the requested visual scene,*" because it appears that the playback in *White* can be resumed from the point of video interruption (*e.g.* by SMPTE code, disk address,

time offset, *etc.*) not a requested visual scene.

Additionally, *Lewis* fails to teach the emphasized claim features because *Lewis* appears, *arguendo*, to describe the functions of a DVD player, and not a STT and its interaction with a the headend in a VOD system. Therefore, *Lewis* simply does not appear to disclose, teach, or suggest any interaction with a headend, let alone "***receiving a second user input configured to request from the headend the visual scene*** in the video presentation after the STT has output at least another portion of the video presentation, or responsive to receiving the second user input, ***requesting by the STT that the headend send the video presentation***" beginning from the requested visual scene.

On page 4, section 6 of the FINAL Office Action dated September 8, 2006, the Examiner states, in the context of what *White* allegedly teaches, that while "the reference teaches that the system is operable to facilitate and control the particular playback of the on-demand presentation from the "server" [12] in association with various video playback commands, the reference is silent with respect to the particular 'bookmarking' as claimed." The Examiner then cites *Lewis* on page 7 of the FINAL Office Action as a basis to support the alleged teaching of bookmarking. Applicants respectfully disagree, and as pointed out in Applicants' response dated November 8, 2006 (page 12), *Lewis* fails to teach the emphasized claim features because *Lewis* appears, *arguendo*, to describe the functions of a DVD player, and not a STT and its interaction with a headend in a VOD system as recited in claim 80.

The FINAL Office Action also alleges on pages 6-7 that:

> . . .it would have been obvious to one having ordinary skill in the art to modify the VOD playback system [10] and in particular the digital video apparatus or 'STT' [14] of White et al. to ". . . receiving a second user input configured to request from the headend the visual scene in the video presentation after the STT has output the at least another portion of the STT that the headend send the video presentation beginning from the requested video scene;". . . for the purpose of advantageously providing a method that allows the user to avoid the inconvenience of having to manipulate various keys in order to locate and start playback from a selected location within a video presentation (Lewis et al.: Page 2, Lines 4-14).

Applicants respectfully disagree. Applicants respectfully submit that it would not have been obvious to combine *White* and *Lewis,* and the combination is unreasonable because the there is considerable complexity involved in bookmarking content from the headend of a VOD network that is not addressed in either of the prior art references.

Specifically, *Lewis* makes no reference to VOD systems or networks, and only appears to teach bookmarking in a local client with no external content. Bookmarking local content in a local client is considerably more simple and different than bookmarking content that is received over a VOD network. Additionally, *White's* failure to describe bookmarking, and lack of any reference to a feature of displaying video content after a "pause," "stop," or other interruption further demonstrates that it would not be obvious to combine the cited references, and that the Office Action's combination of the references is unreasonable.

In addition, Applicants respectfully submit that the combination of *Lewis* and *White* is not obvious, and thus there is clear legal error. As explained on page 13 of Applicants' response dated November 8, 2006, *White* (presented in the context of interactive video programming methods between an entertainment headend over a network to client terminals, as explained in the Abstract) describes no bookmarking and no delivery of content from a given video presentation after a stop or pause function. The Examiner, apparently relying on a single sentence (page 3, starting at line 14) in *Lewis*, states on page 5 of the FINAL Office Action that *Lewis* "discloses a method that is described as being applicable to any digital video apparatus that allows for the digital video apparatus to quickly locate a particular data block and begin playback from a selected location." As stated in Applicants response (page 13) dated November 8, 2006, the combination of *White* and *Lewis* is unreasonable because there is considerable complexity involved in bookmarking content from the headend of a VOD network that is not addressed or adequately disclosed in the art references.

In the Advisory Action dated November 27, 2006 (Continuation sheet), the Examiner replies to Applicants' arguments from the November 8th response by stating that "irrespective of complexity, the particular knowledge required to perform headend based 'bookmarking' is within the ordinary skill in the art as evidenced by the art of record (ex. Budow et al. (US Pat No. 5,625,864), Goode et al. (US Pat No. 6,166,730), etc.)." Applicants respectfully submit that, even assuming *arguendo Budow* and/or *Goode* can be combined with *Lewis* and *White* (a showing of which has not been made), *Budow* and *Goode* still fail to disclose the above mentioned essential elements of claim 80. For instance, *Budow* does not teach continual feed of video after an interruption.

Thus, for at least these reasons, independent claim 80 is not anticipated by *White* in view of *Lewis*, and Applicants respectfully request that the rejection of claim 80 be overturned.

Because independent claim 80 is allowable over the art of record, dependent claims 82, 83, 85, 86, and 90-92 are allowable as a matter of law for at least the reason that the dependent claims 82, 83, 85, 86, and 90-92 contain all elements of their respective base claim. See, *e.g., In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

B.   Independent Claim 96

Claim 96 recites (with emphasis added):

96.   A television set-top terminal (STT) coupled via a bi-directional communication network to a server located remotely from the STT in a cable television headend, said STT comprising:
    a tuner configured to receive a motion video presentation provided by the server located in the cable television headend, wherein the video presentation is a video-on-demand presentation;
    a memory; and
    a processor that is programmed to enable the STT to,
        output at least a portion of the motion video presentation as a video-on-demand television signal,
        store information related to a visual scene contained in the motion video presentation only in the memory of the STT responsive to the STT receiving a first user input associated with the visual scene, without stopping

output of the motion video presentation, wherein the first user input includes a character sequence to be assigned to the visual scene, and wherein the information related to the visual scene includes data corresponding to the character sequence,

output at least another portion of the motion video presentation as a video-on-demand television signal,

receive a second user input configured to request from the headend the visual scene in the video presentation after the STT has output the at least another portion of the motion video presentation,

responsive to receiving the second user input at the STT, request that the headend send the motion video presentation beginning from the requested visual scene,

receive from the headend the motion video presentation beginning from the requested visual scene, and

output responsive to the STT receiving a second user input a video-on-demand television signal comprising a portion of the motion video presentation starting from a location corresponding to the visual scene, including using information related to the visual scene stored only the memory of the STT,

wherein the video-on-demand television signal comprising the portion of the motion video presentation starting from a location corresponding to the visual scene is output after the at least another portion of the motion video presentation is output as a video-on-demand television signal.

For similar reasons presented above in association with independent claim 80, Applicants respectfully submit that *White* in view of *Lewis* does not disclose, teach, or suggest at least the above emphasized claim features. Specifically, neither *White* nor *Lewis* appear to teach bookmarking VOD content received from a headend. Additionally, the Applicants respectfully submit that the combination of *White* in view of *Lewis* is not obvious due to the complexity in implementing a VOD bookmarking system, which does not appear to be addressed in either *White* or *Lewis*. Accordingly, Applicants respectfully submit that independent claim 96 is allowable over the art of record, and hence respectfully request that the rejection be overturned.

Because independent claim 96 is allowable over the art of record, dependent claims 97-100 are allowable as a matter of law.

II. Discussion of Rejections of Claims 93-95 and 101 Under 35 U.S.C. § 103(a) pertaining to *White* in view of *Lewis* and in further view of *Wang*

    A.   Dependent Claim 93

Applicants respectfully submit that *White* in view of *Lewis* fails to disclose, teach, or suggest at least the above-emphasized claim features of independent claim 80 for at least the reasons presented above. Further, Applicants respectfully submit that *Wang* fails to remedy these deficiencies. Since claim 93 incorporates the features of allowable claim 80, Applicants respectfully submit claim 93 is allowable as a matter of law, and thus, respectfully request that the rejection to claim 93 be overturned.

    B.   Dependent Claims 94

Applicants respectfully submit that *White* in view of *Lewis* fails to disclose, teach, or suggest at least the above-emphasized claim features of independent claim 80 for at least the reasons presented above. Further, Applicants respectfully submit that *Wang* fails to remedy these deficiencies. Since claim 94 incorporates the features of allowable claim 80, Applicants respectfully submit claim 94 is allowable as a matter of law, and thus, respectfully request that the rejection to claim 94 be overturned.

    C.   Dependent Claims 95

Applicants respectfully submit that *White* in view of *Lewis* fails to disclose, teach, or suggest at least the above-emphasized claim features of independent claim 80 for at least the reasons presented above. Further, Applicants respectfully submit that *Wang* fails to remedy these deficiencies. Since claim 95 incorporates the features of allowable claim 80, Applicants respectfully submit claim 95 is allowable as a matter of law, and thus, respectfully request that the rejections to claim 95 be overturned.

D.   Dependent Claim 101

Applicants respectfully submit that *White* in view of *Lewis* fails to disclose, teach, or suggest at least the above-emphasized claim features of independent claim 96 for similar reasons to those presented above. Further, Applicants respectfully submit that *Wang* fails to remedy these deficiencies. Since claim 101 incorporates the features of allowable claim 96, Applicants respectfully submit claim 101 is allowable as a matter of law, and thus, respectfully request that the rejection to claim 101 be overturned.

For at least the forgoing reasons, it is Applicants' position that a *prima facie* for obviousness has not been made against Applicants' claims, and thus the rejections to claims 80, 82, 83, 85, 86, and 90-101 should be overturned.

<u>CONCLUSION</u>

Based upon the foregoing discussion, Applicants respectfully request that the Examiner's FINAL rejection of claims 80, 82, 83, 85, 86, and 90-101 be overturned by the Board, and that the application be allowed to issue as a patent with all pending claims 80, 82, 83, 85, 86, and 90-101.

In addition to the claims shown in the claims Appendix VIII, Appendix IX attached hereto indicates that there is no evidence being attached and relied upon by this brief. Appendix X attached hereto indicates that there are no related proceedings.

Applicant provides an accompanying credit card authorization for the $500 associated with this Appeal Brief. No additional fees are believed to be due in connection with this document. If, however, any additional fees are deemed to be payable, authorization is hereby given to charge any such fees to deposit account No. 20-0778.

Respectfully submitted,

/dr/_____
David Rodack
Reg. No.: 47,034

VIII. CLAIMS - APPENDIX

80.   A method implemented by a television set-top terminal (STT) coupled via a bi-directional communication network to a server located remotely from the STT in a cable television headend, said method comprising steps of:

receiving via a tuner in the STT a video presentation provided by the server located in the cable television headend, wherein the video presentation is a video-on-demand presentation;

outputting by the STT at least a portion of the video presentation as a video-on-demand television signal;

receiving a first user input associated with bookmarking a visual scene contained in the video presentation, including receiving a character sequence to be assigned to the visual scene while the video presentation is being presented to the user;

storing information related to the visual scene in a memory of the STT responsive to receiving the first user input, including storing only in the memory of the STT information related to the visual scene in response to receiving the first user input, including storing only in the memory of the STT data corresponding to the character sequence in response to receiving the user input configured to assign the character sequence to the visual scene;

outputting by the STT at least another portion of the video presentation as a video-on-demand television signal;

receiving a second user input configured to request from the headend the visual scene in the video presentation after the STT has output the at least another portion of the video presentation;

responsive to receiving the second user input, requesting by the STT that the headend send the video presentation beginning from the requested visual

scene;

receiving by the STT from the headend the video presentation beginning from the requested visual scene; and

outputting by the STT a video-on-demand television signal comprising a portion of the video presentation starting from a location corresponding to the visual scene responsive to the second user input, wherein the location corresponding to the visual scene is identified by the STT using the information related to the visual scene, including using information related to the visual scene stored only in the STT.

82.   The method of claim 80, further comprising receiving a plurality of user inputs configured to assign a plurality of respective character sequences corresponding to a plurality of respective visual scenes that were bookmarked responsive to a plurality of respective user inputs.

83.   The method of claim 80, further comprising the step of:

receiving a user input configured to request information related to the visual scene in the video presentation; and

providing the requested information responsive to receiving the user input configured to request information.

85.   The method of claim 80, further comprising outputting information confirming that the visual scene has been bookmarked, wherein the information overlays a minority portion of a television screen being used to display the video presentation.

86.   The method of claim 85, wherein the information confirming that the visual scene has been bookmarked includes at least one of a banner and an icon.

90.   The method of claim 80, wherein the visual scene is associated with a bookmark list associated with a plurality of visual scenes associated with a plurality of respective user inputs.

91.   The method of claim 80, further comprising associating a plurality of visual scenes with a plurality of respective bookmark lists associated with a plurality of respective users responsive to a plurality of respective user inputs.

92.   The method of claim 80, further comprising associating a plurality of visual scenes with a plurality of respective bookmark lists associated with a plurality of respective video presentations responsive to a plurality of respective user inputs.

93.   The method of claim 80, further comprising:

after expiration of a rental access period corresponding to the video presentation, prompting the user to provide input indicating whether the information is to be deleted from the memory of the STT.

94.   The method of claim 80, further comprising:

storing an image corresponding to the visual scene in a memory of the STT responsive to receiving the first user input.

95.   The method of claim 80, wherein the second user input requesting the visual scene corresponds to a thumbnail image corresponding to the visual scene, the thumbnail image being simultaneously provided with a plurality of thumbnail images corresponding to a plurality of visual scenes in the video presentation.

96.   A television set-top terminal (STT) coupled via a bi-directional communication network to a server located remotely from the STT in a cable television headend, said STT comprising:

a tuner configured to receive a motion video presentation provided by the server located in the cable television headend, wherein the video presentation is a video-on-demand presentation;

a memory; and

a processor that is programmed to enable the STT to,

output at least a portion of the motion video presentation as a video-on-demand television signal,

store information related to a visual scene contained in the motion video presentation only in the memory of the STT responsive to the STT receiving a first user input associated with the visual scene, without stopping output of the motion video presentation, wherein the first user input includes a character sequence to be assigned to the visual scene, and wherein the information related to the visual scene includes data corresponding to the character sequence,

output at least another portion of the motion video presentation as a video-on-demand television signal,

receive a second user input configured to request from the headend the visual scene in the video presentation after the STT has output the at

least another portion of the motion video presentation,

responsive to receiving the second user input at the STT, request that the headend send the motion video presentation beginning from the requested visual scene,

receive from the headend the motion video presentation beginning from the requested visual scene, and

output responsive to the STT receiving a second user input a video-on-demand television signal comprising a portion of the motion video presentation starting from a location corresponding to the visual scene, including using information related to the visual scene stored only the memory of the STT,

wherein the video-on-demand television signal comprising the portion of the motion video presentation starting from a location corresponding to the visual scene is output after the at least another portion of the motion video presentation is output as a video-on-demand television signal.

97.   The STT of claim 96, wherein the visual scene is associated with a bookmark list associated with a plurality of visual scenes corresponding to a plurality of respective user inputs.

98.   The STT of claim 96, wherein the processor is programmed to associate a plurality of visual scenes with a plurality of respective bookmark lists associated with a plurality of respective users responsive to a plurality of respective user inputs.

99. The STT of claim 96, wherein the processor is programmed to associate a plurality of visual scenes with a plurality of respective bookmark lists associated with a plurality of respective motion video presentations responsive to a plurality of respective user inputs.

100. The STT of claim 96, wherein the processor is configured to prompt the user to provide input indicating whether the data is to be deleted from the memory of the STT.

101. The STT of claim 96, wherein the processor is configured to enable the STT to store in the memory an image corresponding to the visual scene responsive to receiving the first user input.

IX. <u>EVIDENCE - APPENDIX</u>

(None)

X. <u>RELATED PROCEEDINGS - APPENDIX</u>

(None)